#8 Attachments

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Customer No.: 07278
PATENT TRADEMARK OFFICE

Docket No: 9386/1F215-US1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Albhy Galuten

Serial No. 09/486,759 Art Unit: 2154

Confirmation No.: 4604

Filed: June 8, 2000 Examiner: Gregory L. CLINTON

For: **METHOD AND SYSTEM FOR TRANSMITTING MEDIA INFORMATION THROUGH A NETWORK**

DECLARATION UNDER 37 C.F.R. § 1.131

Hon. Assistant Commissioner of
Patents and Trademarks
Washington, DC 20231

June 26, 2003

Sir:

I, Albhy GALUTEN, being duly sworn, depose and say:

1. I am the inventor of the patent application identified above and I am the inventor of the subject matter described and claimed therein.

2. Prior to June 29, 1998, the effective date of the Bayrakeri reference (U.S. Patent No. 6,185,602) and prior to the effective date of the Borella et al. reference (U.S. Patent No. 6,182,125 - filed October 13, 1998) (hereinafter "Borella"), I had completed my invention as described and claimed in the subject application in this country, a NAFTA country, or a WTO member country. My invention was conceived in full, and due diligence was used to reduce it to practice, for example by filing this patent application. As evidence that my work antedates Bayrakeri, I refer to Exhibit 1, the document entitled Preliminary UMP Viewer Application Functional Specification & Software Requirements, Version 2.85 (hereinafter "UMP Viewer Spec") and Exhibit 2, the document entitled Preliminary UMP Viewer Application Functional Specification & Software Requirements - Section Three Infrastructure to Support Deployment of the UMP Player, Version 0.607 (hereinafter "Infrastructure Spec"). Both the UMP Viewer Spec and the Infrastructure Spec are in-house specifications. Dates and certain other proprietary disclosures appearing in this document have been redacted. I declare that these documents (Exhibits 1 and 2) were created before June 29, 1998.

3. Claims 1-28 are pending in my application. With respect to the subject matter of claims 1, 4, and portions of the subject matter of claims 6, 9, 11-16, and new claims 21-27 my UMP Viewer Spec (Exhibit 1) discloses a method for transmitting media information over a network by generating a handle at a first location where the handle identifies a media object; transmitting the handle from the first location to a second location through the network; and rendering the identified media object at the second location in accordance with the handle by displaying video content and producing audio content.

4. For example, the UMP Viewer Spec (Exhibit 1) discloses that to "synchronize Online activities ... [e.g. w]eb links, email, Instant Messaging ...will be through the Edit Decision Lists (EDL's)" and "EDLs will only consist of references to media contents, and not embed the contents themselves," pages 10 and 36. The EDL "can be sent to other users." UMP Viewer Spec (Exhibit 1), page 36. Thus, the EDL is an embodiment of a "handle" as recited in the claims.

5. Further, UMP Viewer Spec (Exhibit 1), in general, describes the functionality of the Universal Media Player (UMP) wherein the UMP renders media objects in accordance with the EDL. The UMP

> will be able to view, play or execute multiple types of content. Supported types will be audio data in PAC/ACC and DTS formats, video in AVI, QuickTime & MPEG1 formats, JPEG, BMP & GIF pictures, text in HTML, RTF, and ASCII formats and Windows 95 compatible executable & object files. UMP will also be able to read and generate Edit Decision Lists (EDLs). EDLs will allow authors and users to describe simultaneous or sequential played sequences of the supported types of content and, the UMP will be able to play & record these sequences.

UMP Viewer Spec (Exhibit 1), pages 9-10, and *see*, Diagram Two, page 11. These early descriptions provide the methods and structures of the presently claimed invention.

6. Regarding the remaining subject matter of claims 6, 12 and 15, an object-id; a sku-id; a distributor-id; a retailer-id; a channel-id; a renderer-id; a carrier-id; a disk-id; a user-id; an absolute-time-id; a temporal-location-id; and a temporal-state-id are supported by the UMP Viewer Spec (Exhibit 1). The UMP Viewer Spec (Exhibit 1), on pages 50-52, discloses that the EDL contains a number of identifiers, including time information for synchronization and the temporal information regarding the media. The figure on page 51 of the UMP Viewer Spec

(Exhibit 1) illustrates some of the other information stored in the EDL, including the identification of specific content, for example, "Play SONG 1". The Infrastructure Spec (Exhibit 2) further discloses how content can be identified. Specifically, "to uniquely identify an object, this object will be assigned an Object ID or OID" and this OID is readable by the EDL. Infrastructure Spec (Exhibit 2), pages 9-10. Infrastructure Spec (Exhibit 2), on page 10, also describes using "SKU's as OID's", "Channel Identifiers" including a "Retailer ID, or RID" and a "Distributor ID or DID".

7. Regarding claims 9 and 11, the feature of identifying a value-chain participant is supported by the disclosure described in the above paragraph 4 because an OID

> will have attributes ... [and t]he current set of properties fall into two categories, creator and owner. The creator set will include the Artist(s), Writer(s),Musicians(s), producer(S) [sic] ... and provide the information for PRO and other mandated rights management functions. The Owner properties will define the owner of the copyright in both the song, Publisher(s), and the recording, Music Company(s) as well as the distribution channel (s) if appropriate.

Infrastructure Spec (Exhibit 2), page 10.

8. Additional disclosure supporting the identification of a value-chain participant is that a "Reference Function maintains information about all the OID's, CID's and RID's, their relationships (associations) and selected relevant information (e.g., the expiration date, a brief description of offers and content objects, etc.)." Infrastructure Spec (Exhibit 2), page 22.

9. Additionally, claim 11 and a feature of claim 14 requires the transmission of the handle from the second user to the server and receiving from the server the media object identified by the handle. The UMP Viewer Spec (Exhibit 1) discloses that the EDL can be sent to anyone and contains all the information required to purchase rights to the content. The EDL can "contain all of the information regarding how to purchase the rights to non-owned content so that the recipient of the EDL is able to enjoy the same experience as the creator of the EDL." UMP Viewer Spec (Exhibit 1), page 34. Thus, once the user purchases the content, the user then receives a media object from a server. *See,* UMP Viewer Spec (Exhibit 1), page 34.

10. Regarding the additional subject matter of claims 13-16, and new claims 23-25, claims 13 and 23 recite that the rendering of the media object at the first location is synchronized with the rendering of the media object at the second location. The UMP Viewer Spec (Exhibit 1) discloses the synchronization of renderings on e.g., pages 32, 33, 50, and 51 and the Infrastructure Spec (Exhibit 2) on page 33. "A key function of the operation of the EDL is the notion of synchronization. The players will then begin at the pre determined time, giving a sync play." UMP Viewer Spec (Exhibit 1), page 50.

11. The 'time calculation' element of claim 16 is further disclosed in UMP Viewer Spec (Exhibit 1) on pages 36 and 50-51, which discloses computing a transport time and then rendering a media object incremented by the transport time.

12. Regarding new claims 26-28, claiming activating a chat session between a first user and a second user based on the type of content being rendered. The first user can begin rendering content and the claimed invention will search for a second user rendering similar content and allow the first user to chat with the second user. Additionally, the first user can just search for a second user rendering particular content and the first user can initiate a chat session with the second user. Support for the claimed features is found in the UMP Viewer Spec (Exhibit 1), wherein the

> Chat & Buddy List
> When users sign up for purchasing music with DigiBoxes they will be able to decide if they want to disclose their interests to affinity groups of other users utilizing the UMP viewer technology. They will be able to participate in dynamic chat communities and be able to communicate with users that allow themselves to be "seen" over the network. The UMP viewer application will store a protected set of chat group pointers, and collections of users. A 3rd party [redacted] application will enable the users to participate in chat, and will monitor other users who are connected and have given permission to be monitored. Users will be able to turn on or off (visible check list) their association with dynamic groups on the fly. Users will, dynamically, be able to make themselves available/unavailable to other fans listening to the same song or same EDL, and synchronize listening with them.

UMP Viewer Spec (Exhibit 1), page 33.

13. Again, the UMP Viewer Spec (Exhibit 1) and the Infrastructure Spec (Exhibit 2) discloses all of the subject matter recited in claims 1, 4, 6, 9, 11-16, and new claims 21-28. The description was made before June 29, 1998 and antedates both the Bayrakeri and Borella references.

14. I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements Ire made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Albhy GALUTEN

6-27-03
Dated